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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,593	02/22/2002	Akira Hamamatsu	16869P-041800US	5740

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EXAMINER

TRINH, HOA B

ART UNIT	PAPER NUMBER
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2814

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/082,593	Applicant(s) HAMAMATSU ET AL.	
	Examiner Vikki H. Trinh	Art Unit 2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-8,10,14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/02/2007 has been entered.

Acknowledgement

Applicant's amendment filed on 01/16/2007, has been considered and entered. Claims 1-2, 4-8, 10, and 14-15 are pending.

Specification

2. The amendment filed 01/16/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the steps of "accessing a design database to down load design information that identified using the received product name and the received process name"; "processing the down loaded design information to set temporary inspection conditions..."; and the step of "executing a trial inspection of the semiconductor device to detect defects, wherein the trial inspection is executed using the set temporary inspection conditions".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. Claims 1-2, 4-8, 10 and 14-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The drawings and the original specification do not show support for the following limitations: In claims 1, 4, 7-8, 10 and 14-15, the steps of “accessing a design database to down load design information that identified using the received product name and the received process name”; “processing the down loaded design information to set temporary inspection conditions...”; the step of “executing a trial inspection of the semiconductor device to detect defects, wherein the trial inspection is executed using the set temporary inspection conditions”. In claims 2, 5-6, the phrase “an inaccurately detected defect is likely to occur” raises new matter.

The examiner notes that in the Advisory Action, the examiner has already directed applicants' attention to the original specification which does not appear to support applicants' claim limitations.

Nevertheless, in order to expedite the prosecution process, the examiner assumes that the new matter will be deleted in response to this Office Action. The remaining limitations without the new matter are being addressed below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-2, 4-8, 10, 14-15 are rejected under 35 U.S.C. 102(a) as being anticipated by Admitted Prior Art (APA), specification pages 2-4 and figure 1.

As to claims 1, 4, 7, 10, APA discloses a method for setting inspection conditions for semiconductor devices having the steps of setting (step 5, fig. 1) by inherently accessing a communication device a design database with inputting product name and process name from a terminal and deriving design information from the database, an inspection condition (step 4, fig. 1; inspecting the devices with the inspection condition (step 5, fig. 1) set by using design information derived from said design database (step 4, fig. 1); classifying the detected defects according to the inspection condition which may include whether the defect is on an optically transparent film or not (note, APA teaches the step of specifying the inspected areas and excluded areas); revising (step 10, fig. 1) said inspection condition by using data obtained by the inspecting ; and inspecting semiconductor devices using said revised inspection condition (step 11 and step 12, fig. 1) and then outputting results of the inspection(step 13, fig. 1) . See figure 1.

As to claims 2,5, 14, the method includes the inspection conditions (step 5, APA, fig. 1) set that includes the information whether or not an area for inspection is in an area in which false alarms tend to occur (APA, step 8, figure 1). This allows the defects detected to be classified according to areas to be included or excluded (step 8, fig. 1). The method includes the step of automatically setting is performed. APA, step 11, fig. 1, shows the step of setting an inspection sensitivity to a level to suit design rules for each area within a semiconductor device chip.

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As to claims 6, and 15, inspection conditions are revised (step 10, fig. 1) so that faulty matter is detected based on the results of a review and classification of defects detected during inspection of the devices. See figure 1 and page 4, second paragraph.

As to claim 8, the images are displayed on a screen. See specification, page 2, first paragraph.

Response to Arguments

Applicant's arguments filed have been fully considered but they are not persuasive.

Note that applicants have argued that the prior art does not disclose the step of accessing via a communication device a design database with inputting product name and process name from a terminal and deriving design information from said database. The examiner has disagreed. The admitted prior art (APA) applies to the amended claims, because step (3) and step (4) show that one has to enter the wafer size and product name and process name from an inherent terminal that has stored database information of the inspection condition. In addition, APA teaches that the step of specifying the inspected areas and excluded areas to be inspected. The results of the inspecting step would result in a "classified" defects because there are areas that are excluded from the inspection. The optically transparent film is an inspected area. Thus, the rejection is proper.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Vikki Trinh whose telephone number is (571) 272-1719. The Examiner can normally be reached from Monday-Friday, 9:00 AM - 5:30 PM Eastern Time. If

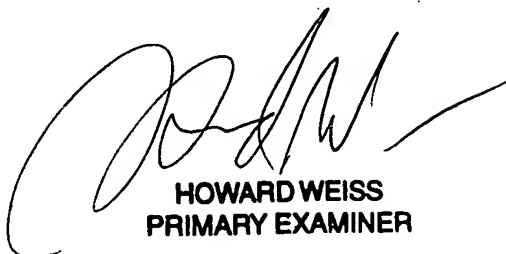
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attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Wael Fahmy, can be reached at (571) 272-1705. The office fax number is 703-872-9306.

Any request for information regarding to the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Also, status information for published applications may be obtained from either Private PAIR or Public Pair. In addition, status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. If you have questions pertaining to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Lastly, paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office actions as of June 2004. Paper copies of foreign patents and non-patent literature will continue to be included with office actions. These cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. patent or patent application publications will not be granted.

Vikki Trinh,
Patent Examiner
AU 2814



HOWARD WEISS
PRIMARY EXAMINER